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REMARKS

Claims 1-78 were originally presented in the subject application. Claim 78 has hereinabove been amended to correct a typographical error, and claims 79-81 have been added to more particularly point out and distinctly claim the subject invention. No claims have herein been canceled. Claims 1-72, 74 and 75 have been withdrawn as directed to non-elected inventions. Therefore, claims 1-81 remain in this case, with only claims 73 and 76-81 being actively examined.

The addition of new matter has been scrupulously avoided. In that regard, support for the addition of claims 79-81 can be found in the specification at, for example, numbered paragraph 0027.

Applicant respectfully requests reconsideration and withdrawal of the various grounds of rejection.

Restriction Requirement

The Office Action maintained the verbal restriction requirement under 35 U.S.C. §121. The claims of the application were restricted to Group I (claims 1-53), Group II (claims 54-72), and Group III (claims 73-78). Further, the Group III claims were restricted to species A (claims 73, 74, 77 and 78), B (claims 73, 75, 77 and 78) and C (claims 73 and 76-78).

Applicants undersigned attorney verbally elected the claims of Group III, species C, i.e., claims 73 and 76-78. Applicant hereby affirms that election. However, as noted in the Office Action, claim 73 is currently a generic claim. If allowed, Applicant will have the right to bring claims 74 and 75 (i.e., species A and B) back into active prosecution.

35 U.S.C. §102 Rejection

The Office Action rejected claims 73 and 77-78 under 35 U.S.C. §102(b or e), as allegedly anticipated by Tanahashi et al. (Japanese Patent No. JP 2002-34870) using Tanahashi et al. (U.S. Patent Application Publication No. 2004/0234428 A1) as a translation (§102(b)), or as reference (§102(e)). Applicant respectfully, but most strenuously, traverses this rejection.

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As an initial matter, Applicant notes that the Japanese reference number provided in the Office Action (JP 2002-34870) does not appear to match the U.S. Patent Application Publication cited. The Japanese reference number corresponding to the cited U.S. Patent Application Publication is JP 2001-157701. Applicant requests confirmation and correction of the Notice of References Cited that was included with the Office Action.

Claim 73 recites, for example, a flexible filament for a turbine brush seal having a cross-sectional shape of an n-point star, wherein n is at least 3. A text search of Tanahashi et al. reveals that the only place where a star shape is mentioned is in numbered paragraph 0502, wherein nozzle shapes are mentioned. No other additional information is given regarding the actual shape of the fiber made with the nozzle. Thus, for the sake of argument, there is at best the mere suggestion of a star-shaped ceramic fiber made from the star-shaped nozzle.

The parent application to the present application contained the basic disclosure of a star-shaped flexible filament for a turbine brush seal. Thus, since the present case is a CIP, it is entitled to the filing date of the parent for any common subject matter. The filing date of the parent was October 25, 2001. Thus, for the star shape, the present application is entitled to the parent filing date.

The effective filing date of Tanahashi et al. for purposes of §102(e)(2) is the §371(c) date (i.e., proper national entry into U.S. from PCT), because the PCT counterpart of Tanahashi et al. was published in Japanese. The §371 (c) date is given as January 26, 2004. The filing date of the parent application to the present application predates this by more than two years. Therefore, Applicant submits Tanahashi et al. is not a proper reference under §102(e).

However, the effective filing date of Tanahashi et al. for purposes of §102(b) is the earliest publication date in the chain. The earliest publication occurred in Japan on December 4, 2002. The filing date of the parent application to the present application predates this by more than a year. Therefore, Applicant also submits Tanahashi et al. is not a proper reference under §102(b).

Even ignoring the above, there is an additional basis that Tanahashi et al. does not anticipate the present invention. Claim 73 also recites, for example, sustaining a minimum temperature for at least about 10,000 hours. As noted in the Office Action, the Tanahashi et al.

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ceramic fiber is used to fabricate a holding seal member for an automobile catalytic converter. The Office Action goes on to allege that the ceramic fibers are expected to last for significantly greater than 10,000 hours; "[o]therwise, one would have to replace repeatedly a holding seal material for just a little over a period of 1 year." Applicant disagrees with this time frame. The quoted statement would assume operation of the catalytic converter for 24 hours a day. Applicant submits it is unrealistic to think that an automobile would be run, on average, for more than a few hours a day (think about the average commute to work). Using that time frame, 10,000 hours would result in over nine years. Applicant submits it is reasonable to assume replacement of a catalytic converter prior to nine years of use. Thus, Applicant submits Tanahashi et al. does not teach or suggest the claimed minimum time.

Therefore, Applicant submits that Tanahashi et al. is improperly cited, and in any case, does not anticipate the present invention.

The Office Action also rejected claims 73, 77 and 78 under 35 U.S.C. §102(b) as allegedly anticipated by Dobo et al. (U.S. Patent No. 4,175,153). Applicant respectfully, but most strenuously, also traverses this rejection.

Claim 73 recites, for example, that the flexible filament is capable of sustaining temperatures of at least a minimum temperature for at least about 10,000 hours, and wherein the minimum temperature is about 400° C.

Dobo et al. is directed to a hollow fiber for separating one gas (hydrogen) from another, or one liquid from another, and is suggested for use with fuel cells. See the first paragraph under Field of Invention in column 1 of Dobo et al. Although the Office Action admits that the above combination of time and temperature is not explicitly disclosed in Dobo et al., such is nonetheless alleged to be inherent therein.

Dobo et al. was issued in 1979 and filed in 1978. The technology therein is thus about 25 years old. Applicant submits that modern fuel cell development cannot even achieve 10,000 hour longevity without clogging, much less technology from 25 years ago. The Examiner is encouraged to do a search for, e.g., "fuel cell clogging," which will produce numerous articles discussing modern proposed solutions. However, in the context of hydrogen fuel cells for laptops, for example, the goals are to match or exceed modern lithium ion batteries, which work

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for up to five or so hours, far less than 10,000. Thus, Applicant submits the claimed time is not inherent in Dobo et al.

Moreover, Applicant submits any temperatures disclosed in Dobo et al. (e.g., at the top of column 35) are process temperatures, i.e., the process of making the hollow fibers, rather than using the hollow fibers. In addition, Applicant submits it is well known that fuel cells do not operate at the claimed temperature range. Thus, Applicant submits the claimed temperature is also not inherent in Dobo et al.

Therefore, Applicant submits that claim 73 cannot be anticipated by Dobo et al.

35 U.S.C. §103 Rejection

The Office Action rejected claim 76 under 35 U.S.C. §103, as being obvious over Tanahashi et al. (Japanese Patent No. JP 2002-34870) using Tanahashi et al. (U.S. Patent Application Publication No. 2004/0234428 A1) for English translation (based on §102(b)), or the Tanahashi et al. U.S. Publication (based on §102(e)). Applicant respectfully, but most strenuously, traverses this rejection.

As an initial matter, Applicant does not acquiesce to the allegation that "...a star-shaped fiber having arcuate pointed portions is old in the art." Nothing presented in the Office Action provides proof of this allegation. For example, none of the shapes in FIG. 9 of Tanahashi et al. qualifies as the claimed n-point star, where n is at least 3. Note that "n-point star" is defined in the present application at numbered paragraph 0039, with specific examples described in the paragraphs following and referencing the drawings.

Moreover, in order to qualify as a proper reference under §103, Applicant submits that Tanahashi et al. must first qualify as a reference under §102. However, as noted above with respect to the §102 rejection, Tanahashi et al. fails to so qualify.

Therefore, Applicant submits that claim 76 cannot be rendered obvious over Tanahashi et al.

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CONCLUSION

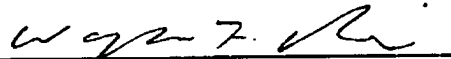
Applicant submits that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claim from which they directly or ultimately depend, as well as for their additional limitations.

Applicant acknowledges the references cited in the Office Action, but not substantively applied. However, Applicant submits that the pending claims are patentable thereover as well.

For all the above reasons, Applicant maintains that the claims of the subject application define patentable subject matter and earnestly requests allowance of claims 73 and 76-81, as well as reinstatement of claims 74 and 75.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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